

REMARKS

In the Office Action of April 27, 2010, claims 1-6, 9, 10, 12-24, 27, 28 and 30-40 were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. Patent No. 5,768,607 (“Drews et al.”) in view of U.S. Patent No. 5,642,171 (“Baumgartner et al.”) and U.S. Patent No. 5,642,171 (“Heinz et al.”).

In response, Applicant respectfully asserts that the Office Action has failed to establish a *prima facie* case of obviousness for independent claims 1, 10, 19, 28, 37 and 39, as explained below. In addition, Applicant has added new claims 41-43. In view of the amendments to the claims and the following remarks, Applicant respectfully requests the allowance of the pending claims 1-6, 9, 10, 12-24, 27, 28 and 30-43.

A. Patentability of Independent Claims 1, 10, 19, 28, 37 and 39

The Office Action has rejected independent claim 1 under 35 U.S.C. 103(a) as allegedly being obvious over Drews et al. in view of Baumgartner et al. and Heinz et al. However, the Office Action has failed to establish a *prima facie* case of obviousness for independent claim 1. As such, Applicant respectfully requests that independent claim 1 be allowed.

The Office Action on page 4 correctly states that “the combination [of the teachings of Drews et al. and Baumgartner et al.] does not appear to teach replaying the operations and accompanying audio using an event recording, wherein the event recording includes all user inputs during event recording and specifically, initial conditions of the original computing environment when the event recording was initiated.” The Office Action then states that Heinz et al. “teaches that initial conditions are recorded so that a training sequence will work as originally intended (see column 2, lines 5-21) and that “[i]t would have been obvious for one of ordinary skill in the art at the time of the invention to combine the teachings of Drews, Baumgartner, and Heinz for the purpose of providing consistent results in a session recording playback.” However,

Heinz et al. teaches away from using initial state described in column 2, lines 5-21. Thus, Applicant respectfully asserts that the Office Action has failed to establish a *prima facie* case of obviousness for independent claim 1.

“When the prior art teaches away from combining certain known elements, discovery of successful means of combining them is more likely to be nonobvious.” *KSR*, 550 U.S. at ___, 82 USPQ2d at 1395. See MPEP 2143. It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). See MPEP 2145.

In the case at hand, Heinz et al. describes the current shortcomings of current simulation programs in the Background of the Invention section, and thus, describes using an actual working copy of a program being taught. In particular, Heinz et al. explains that “in order to use an actual working copy of the program being taught to the user, it is necessary to ensure that the program is placed in a known initial state (i.e. all settings, preferences, and options are set to a known state)” and that “[o]therwise, the training sequence may not work as originally intended.” Heinz et al. then further describes other problems of using an actual copy of the program, e.g., extensive resource requirement – sufficient disk space and random access memory in the training systems and securing the appropriate number of licenses. Thus, rather than using an actual working copy of program for training purposes, as described in the background section, Heinz et al. discloses a simulation generation system that uses bitmaps for the training. In particular, Heinz et al. discloses using a bitmap to initialize the screen before each play, rather than using “a known initial state (i.e. all settings, preferences, and options are set to a known state).” See Fig. 1 and column 4, lines 56-58, of Heinz et al. Thus, Heinz et al. teaches away from using “a known initial state (i.e. all settings, preferences, and options are set to a known state),” which was described in the background section of Heinz et al. Thus, the Office Action has failed to establish a *prima facie* case of obviousness for independent claim 1.

In addition, Heinz et al. does not teach the limitation of “*said event recording including all user inputs to an original computer environment during said event recording and initial conditions of said original computer environment when said event recording was initiated,*” as recited in independent claim 1. As noted above, Heinz et al. states that “in order to use an actual working copy of the program being taught to the user, it is necessary to ensure that the program is placed in a known initial state (i.e. all settings, preferences, and options are set to a known state).” Clearly, this refers to a manual process of setting preferences and options of the program to a known state. There is no mention of the known initial state being included in a recording. Thus, Heinz et al. fails to teach a recording that includes not only user inputs, but also “*initial conditions of said original computer environment when said event recording was initiated,*” as recited in independent claim 1. Thus, the Office Action has failed to establish a *prima facie* case of obviousness for independent claim 1.

For at least the reasons stated above, Applicant respectfully asserts that independent claim 1 is not obvious over Drews et al. in view of Baumgartner et al. and Heinz et al. As such, Applicant respectfully requests that independent claim 1 be allowed.

Independent claims 10, 19, 28, 37 and 39, which include similar limitations to independent claim 1, were also rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Drews et al. in view of Baumgartner et al. and Heinz et al. Although the language of claims 10, 19, 28, 37 and 39 differs from the language of claim 1 and the scope of claims 10, 19, 28, 37 and 39 should be interpreted independently of claim 1, Applicant respectfully asserts that the remarks provided above in regard to claim 1 apply also to claims 10, 19, 28, 37 and 39. Thus, the Office Action has also failed to establish a *prima facie* case of obviousness for claims 10, 19, 28, 37 and 39. As such, Applicant respectfully requests that independent claims 10, 19, 28, 37 and 39 be allowed as well.

II. Patentability of Dependent Claims 2-6, 9, 12-18, 20-24, 27, 30-36, 38 and 40-43

Each of dependent claims 2-6, 9, 12-18, 20-24, 27, 30-36, 38 and 40-43 depends on one of independent claims 1, 10, 19, 28, 37 and 39. As such, these dependent claims include all the limitations of their respective base claims. Therefore, Applicant submits that these dependent claims are allowable for at least the same reasons as their respective base claims.

Applicant respectfully requests reconsideration of the claims in view of the claim amendments and the remarks made herein. A notice of allowance is earnestly solicited.

Respectfully submitted,

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